



05-24-04

3625

JLW

Filed Via Express Mail

Rec. No.: EL 980147449US

On: May 20, 2004

By

Eric L. Maldonado

Any fee due as a result of this paper, not covered by an  
enclosed check, may be charged on Deposit Acct. No. 50-1290.

Attorney Docket No. NECW 18.854 (100806-00078)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor: Haruhiko KINOSHITA  
Serial No.: 09/906,995  
Filed: July 17, 2001  
Title: SYSTEM FOR AND...  
Examiner: Forest Thompson Jr.  
Art Unit: 3625  
Con. No.: 6474

May 20, 2004

Director of the U.S. Patent and  
Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**INFORMATION DISCLOSURE STATEMENT**

S I R:

In order to comply with discretionary rules 37 CFR §§1.97 and 1.98, attached hereto is a copy of Form PTO-1449 and a copy of the documents listed thereon. This document contains information in which the Examiner may consider to be important in deciding whether to issue a patent in the instant application.

As this statement is being filed prior to issuance of a first Office Action, no fee is due.

Also attached is a copy of a Japanese Office Action dated April 6, 2004 from the corresponding Japanese Patent Application. Such Office Action cited nine documents. Five of such documents were cited in an IDS previously submitted on January 15, 2004. All of the documents listed in Form PTO-1449 appear in the Japanese Office Action.

For documents written in a language other than English, English language abstracts are annexed thereto explaining relevancy in accordance with 37 CFR §1.98 (a)(3).

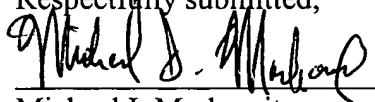
Each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement.

The present Information Disclosure Statement is being submitted in compliance with 37 §CFR 1.56 as an Examiner might consider any cited document important in deciding whether to allow the application to issue as a patent, but the citation of each document is not to be construed as an admission that such document is necessarily relevant or prior art. No representation is intended that the cited documents represent the results of a complete search, and it is anticipated that the Examiner in the normal course of examination, will make an independent search and will determine the best prior art consistent with 37 CFR 1.104 (a), and in the course of such search will review for relevance every document cited on the attached form even if not initialed.

Early and favorable consideration is respectfully solicited.

**Any fee due with this paper may be charged on Deposit Account 50-1290.**

Respectfully submitted,

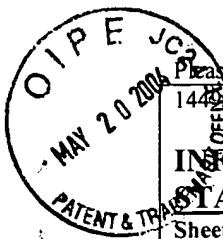
  
Michael I. Markowitz  
Reg. No. 30,659

**CUSTOMER NO.: 026304**

(Tel) 212-940-8800

(Fax) 212-940-8986

Docket No.: NECW 18.854(100806-00078)



Please type a plus sign (+) → +

Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE

1442 PTO

U.S. Department of Commerce  
Patent and Trademark Office

Application No. : 09/906,905

Filing Date : July 17, 2001

First Named Inventor: H. KINOSHITA

Group Art Unit : 3625

Examiner Name : F. THOMPSON JR

Attorney Docket No. : NECW 18.854

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

Sheet 1 of 1

**U.S. PATENT DOCUMENTS**

Examiner Initials	Cite No. <sup>1</sup>	U.S. Patent Document	Kind Code if known <sup>2</sup>	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns Lines Where Relevant Passages or Relevant Figures Appear

**FOREIGN DOCUMENTS**

Examiner Initials	Cite No. <sup>1</sup>	Foreign Patent Document Office <sup>3</sup> Number <sup>4</sup> Kind Code <sup>5</sup> (if known)	Country	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns Lines Where Relevant Passages or Relevant Figures Appear
		11-353359	JP	ORIENT CORP	12/24/1999	
		09-034962	JP	HITACHI LTD, et al.	02/07/1997	
		11-215264	JP	BUERII JAPAN:KK	08/06/1999	

**Other Prior Art-Non Patent Literature Documents**

Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), data, page(s), volume-issue number(s), publisher, country, where published, source.	Applicant check here if English language translation attached
		"BETTING ON A QUICK, DECISIVE BATTLE IN THE SCRAMBLE FOR MILEAGE PROGRAM MEMBERS: ANA'S CTI INTERNET-READY SYSTEM" COMPUTOPIA, JAPAN, COMPUTER AGE CO., LTD., AUGUST 1, 1997 VOL. 32, NO. 371, pp. 56-57	
Examiner Signature		Date Considered	

Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw a line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Unique citation designation number. <sup>2</sup>See attached Kinds of U.S. Patent Documents. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.1<sup>1</sup> if possible. <sup>6</sup>Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

## Reasons

A. Under the provisions of article 29, paragraph 2 of the Patent Law, the invention relating to the following claims of this application may not be granted a patent, because it could easily have been invented by a person who has the usual knowledge in the field of technology to which the invention belongs, prior to the application, based on the inventions that appear in the following publications, which were distributed in Japan prior to the application.

\* \* \*

- Claims: 1-12

- Cited references:

1. "Free air tickets for flight miles, public-private confusion? Consternation among companies, some prohibitions on private use", Asahi Shimbun, Tokyo morning edition, Japan, Asahi Shimbun Co., July 22, 1998, Tokyo morning edition, page 21 (First home)
2. "Ever-expanding mileage service, an unavoidable race for survival", Distribution Service Newspaper, Japan, Nikkan Kogyo Shimbun Co., November 17, 1998, page 1
- / 3. "Betting on a quick, decisive battle in the scramble for mileage program members: ANA's CTI Internet-ready system", Computopia, Japan, Computer Age Co., Ltd., August 1, 1997, Vol. 32, No. 371, pages 56-57
4. Fumiaki Wada, "United Airline's 'Mileage Plus'", CardWave, Japan, C-Media Co., Ltd., December 10, 1999, Vol. 13, No. 1, pages 40-44
- / 5. Unexamined patent H11-215264 [1999]
- / 6. Unexamined patent H9-34962 [1997]
- ! 7. Unexamined patent H11-353359 [1999]
8. Unexamined patent 2000-132609
9. Unexamined patent H11-143977 [1999]

- Remarks:

As seen in cited references 1-2, regarding the approach of "keeping track of mileage companywide", it was an approach that was already widely known in newspapers and magazines.

Here, as a setup relating to the details and as a service for keeping track of mileage, services such as for example in cited references 3-4 are already widely known and have already been put into practice, so

this application's idea of having a mileage information database or passenger information database and setting up an arrangement relating to reservation and reception terminals is included among matters that can arbitrarily be imagined from well known technology, etc.

And cited references 5-6 describe a setup in which one keeps track of company use and personal use, which are kept separate. Thus to separate the attributes as needed when the service is used and to keep track of the balance, history of use, and other factors is an arrangement that is already known and practiced in many fields.

Similarly, as seen in point reassignment services (cited reference 7), having an arrangement in which points of certain attributes are reassigned to the points of other attributes is also a setup that is already known and practiced as a matter of course, so this is not just a characteristic of arrangements in which personal points are moved over to company points.

And cited reference 8 can be referred to with regard to company-individual corresponding information databases. Here, a system is described that carries out processing for specifying member individuals by a database that stores member information and individuals' attributes. To adopt such a setup and do extraction processing of specified persons and processing relating to discounts, etc. is included among setups that can arbitrarily be adopted.

In addition, for modes in which employees' duties (business travel management database) are used between companies, one can refer to, for example, cited reference 9. This kind of arrangement too is among the arbitrary matters that can be adopted as necessary.

Therefore, the arrangements listed in this application are thought to be ones that can arbitrarily be put together by one skilled in the art by adding or modifying known arrangements, so these arrangements themselves have no inventive advancement.

B. In this application, what appears in the specification and drawings does not satisfy the requirements set forth in the Patent Law, article 29, paragraph 1, article 36, paragraph 4 and paragraph 6, number 2, in the following points.

\* \* \*

An invention, as prescribed in article 2 of the Patent Law, means a high-grade creation of a technical idea that makes use of natural laws. Thus in order for what appears in the claims to be an invention, it must be "a technical idea that makes use of natural laws".

Here, the means known as a computer is itself no more than a composition that is realized by known technical means, and thus to make use of hardware shows no particular technical characteristics. Therefore, here no great importance is assigned to the formal point that it is “realized through hardware”, and in a way where it is obvious that it is clearly different from “an act done by a human being (using a computer)”, it is important that it be made clear “that the computation or processing of information according to the purpose is realized on a computer by a software means.”

For example, if it were not stated as “a computer performing a series of information calculation operations (by its built-in program)” but it were merely stated as “a human being causes an arbitrary procedure to be performed (using a computer as a tool)”, then because no technical character is formed as a computer operation method, it is nothing more than a description of a general procedure based simply on a certain arrangement, and it does not qualify as a composition that satisfies the requirement of being “a technical idea that makes use of natural laws” that is prescribed in the Patent Law. Thus even if it is clear that a computer is being used, it is not deemed to be an invention if it is recognized that there is no particular technical characteristic present in the composition of the hardware and that there is no essential difference from a human being causing an operation to be performed in which a computer is used as just a tool.

Therefore, in an invention relating to computer software, it is necessary that it be shown that “by the software being read into the computer, information calculation and processing for the application is realized by a specific means in which the software and the hardware sources work together, and an information processing device or its operation method are built that fits the application.”

Looking at the description of the claims of this application from this perspective, the individual information processing operations merely include abstract, general processing operations such as “receive the passenger”, “transmit”, “receive”, “combine and record”, “make an information inquiry”, “reflect it in the database”, etc., and because the concepts of these operations can all be tied together by an abstract operation on a level that goes far beyond a specific single specific [sic; “specific” is repeated] calculation processing operation on a computer, the applicant has merely created something in which vague operations are described by desired operations and functions, and the desired procedure is shown.

Nor does the detailed description of the invention include anything to support the composition in these claims. For each, there is merely a description of the function or operation to be provided by a device, etc., and the “composition of specific content” of the devices, etc. to realize this (the specific composition, etc. brought about by the software and hardware resources working together) is unclear.

As a result, in the system of this application, there is no specific description that would allow one to grasp that “the computation or processing of information to fit the application is realized by specific means” in the computer, and there is merely an operational and functional description of the individual information processing operations that are carried out with each device, so it is not even clear whether the operation in the device is essentially carried out by a computer or by a human being.

Therefore, even though it may be stated that devices, etc. are used, to try, as in this application, to build a vague system based simply on commercial methods or a certain procedure, in which a human being uses a computer, etc. as a means, with no particular technical characteristics present in the composition of the hardware, is not a specific technical idea, and so does not qualify as an invention.

Thus the description relating to the claims of this invention does not satisfy the requirements set forth in the Patent Law, article 29, paragraph 1, article 36, paragraph 4 and paragraph 6, number 2, and accordingly it may not be granted a patent.

For the details, one can refer to the following examination standards, etc.

- “Examination standards (December 2000)”  
Part II, chapter 1 “Inventions that can be used industrially”  
([http://www.jpo.go.jp/shiryoku/kijun/kijun2/pdf/tt1212-045\\_2-1.pdf](http://www.jpo.go.jp/shiryoku/kijun/kijun2/pdf/tt1212-045_2-1.pdf))  
Part VII, chapter 1 “Computer software-related inventions”  
([http://www.jpo.go.jp/shiryoku/kijun/kijun2/pdf/tt1212-045\\_7-1.pdf](http://www.jpo.go.jp/shiryoku/kijun/kijun2/pdf/tt1212-045_7-1.pdf))
- “Examples of unpatentable business-related inventions (April 2001)”  
([http://www.jpo.go.jp/tetuzuki/t\\_tokkyo/bujinesu/tt1303-090\\_jirei.htm](http://www.jpo.go.jp/tetuzuki/t_tokkyo/bujinesu/tt1303-090_jirei.htm))
- “Court decisions on business-related patents (April 2003)”  
([http://www.jpo.go.jp/tetuzuki/t\\_tokkyo/bujinesu/biz\\_case\\_study.htm](http://www.jpo.go.jp/tetuzuki/t_tokkyo/bujinesu/biz_case_study.htm))

If any reasons for rejection are newly discovered, notice of the reasons for rejection will be given.